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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,740	11/13/2003	James C. Colson	AUS920030394US1	2686
45993	7590	09/27/2007		
IBM CORPORATION (RHF) C/O ROBERT H. FRANTZ P. O. BOX 23324 OKLAHOMA CITY, OK 73123			EXAMINER WALSH, JOHN B	
			ART UNIT 2151	PAPER NUMBER
			MAIL DATE 09/27/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	Application No. 10/713,740	Applicant(s) COLSON ET AL.	
	Examiner John B. Walsh	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/13/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     \* Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/13/2003</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 11- 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim appears drawn to computer software which is non-statutory subject matter. The claims lack an appropriate computer readable storage medium to define a structural and functional interrelationship between a computer program and other elements of a computer which permit the functionality of the computer program to be realized.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-30 (claims 11-20 as best understood) are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,089,287 to Bellotti et al.

As concerns claim 1 and as best understood claim 11, receiving a document by a recipient (column 3, lines 4-12); extracting and storing a plurality of GUID values associated with said document including a GUID for the document itself (SelfGUID) (column 4, line 57; column 16;

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lines 24-26), a GUID indicating a original predecessor document (OriginGUID) (column 13, line 55-column 14, line 2) to which said received document is related, and a GUID indicating an immediate predecessor parent document (ParentGUID) (column 7, lines 1-13; column 13, line 55-column 14, line 2 ) to said received document; composing a new document (figure 11; new message) related to said received document; performing historical participation analysis using said stored GUID values according to a set of user preferences to classify one or more potential recipients (column 17, lines 44-60); and proposing at least one list of recipients (column 14, lines 32-36; column 17, lines 25-31) of said new document according to said potential recipient classifications.

As concerns claims 2, 12 and 22, extracting a plurality of GUID values from a received message comprises extracting a set of metadata values (abstract).

As concerns claims 3, 13 and 23, wherein said step of proposing a list of recipients comprises a step selected from the group of proposing a "To" list of addressees, proposing a "Carbon Copy" list of addressees, and proposing a "Blind Copy" list addressees (column 17, lines 35-31).

As concerns claims 4, 14 and 24, wherein performing historical participating analysis comprises performing an analysis selected from the group of: (a) designating a potential recipient as inactive if said participant has not contributed a document within a specified period of time; (b) designating a potential recipient as inactive if said potential recipient has not contributed a document within a specified recent number of messages; (c) designating a potential recipient as inactive if said potential recipient does not belong to a top portion of a group of potential recipients when rank ordered by number of documents contributed within a

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specified period of time; (d) designating a potential recipient as inactive if said participant has not contributed a specified threshold number of documents within a specified time period; and (e) designating a potential recipient as inactive if said participant has not contributed documents at a rate favorably comparable to an determined pace for an entire group of potential recipients.

As concerns claims 5, 15 and 25, further comprising sending a notice to recipients who have been classified as inactive participants (can compose a message to these participants).

As concerns claims 6, 16 and 26, wherein said step of composing a new document comprises composing a reply message (figure 11).

As concerns claims 7, 17 and 27, wherein said step of composing a new document comprises composing a forwarded message (figure 11; reply or new message can contain fwd message).

As concerns claims 8, 18 and 28, the method as set forth in claim 1 wherein said step of proposing at least one list of recipients comprises a step selected from the group of: (a) replying to all document contributors and document recipients within a current branch of a conversation tree (figure 11; column 14, lines 32-36); (b) replying to document contributors and document recipients within an entire conversation tree; (c) replying to document contributors and document recipients classified as "active participants" within a current branch of a conversation tree; (d) replying only to document contributors and document recipients as "passive participants" within a current branch of a conversation tree; (e) replying only to document contributors and document recipients classified as "passive participants" within an entire tree of conversation; (f) forwarding to all document contributors and document recipients within a current branch of a conversation tree; (g) forwarding to all document contributors and

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document recipients within an entire conversation tree; (i) forwarding only to document contributors and document recipients classified as "active participants" within a current branch of a conversation tree; (j) forwarding only to document contributors and document recipients classified as "passive participants" within a current branch of a conversation tree; and (k) forwarding only to document contributors and document recipients classified as "passive participants" within an entire tree of conversation.

As concerns claims 9, 19 and 29, comprising: associating an OriginGUID value with said new document having a value equal to the OriginGUID value of said received document; associating a ParentGUID value with said new document having a value equal to the SelfGUID of said received document; and associating a new and unique SelfGUID value with said new document (column 16, lines 30-39; column 13, line 55-column 14, line 2; column 14, lines 32-36; associated in thrask).

As concerns claim 10, 20 and 30, comprising composing a new document with new context by performing the steps of: associating a null OriginGUID value and null ParentGUID value with said new document; and associating a new and unique SelfGUID value with said new document (new thrask with new message; column 8, lines 35-37).

### *Conclusion*

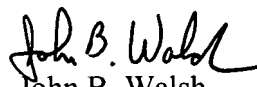
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892. USPN 6,044,205 (metadata); 2003/0163538 (GUID); USPN 5,937161 (mail fwding).

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571-272-3440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
John B. Walsh  
Primary Examiner  
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